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HART  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: MARTIN CULLEN

FOR: TILE WET SAW WITH OUTWARDLY DIVERGING CUTTING MODE

SERIAL NO.: 09/864,350

FILED: May 25, 2001

EXAMINER: Maurina T. Rachuba, Primary Examiner, Art Unit 3723

Hon. Commissioner of Patents  
and Trademarks  
Washington, DC 20231

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Sir:

In the FINAL rejection of 03/07/2002, the Examiner cited In re Casey, 152 USPQ 235 (CCPA 1967). As will be subsequently explained, to address the rejection based on the cited decisional law, applicant amended the claim under consideration. .

Reconsideration is therefore respectfully requested that the amended claim be made of record, since it frames the issue on appeal of which interpretation, that of the examiner or that of the applicant, is to be accorded to In re Casey.

#### ARGUMENT

In In re Casey, the appellant's argument was rejected that the claim preamble<sup>1</sup> distinguished over cited Kienzle, and it made clear that this failing<sup>2</sup> of the argument was the lack of a positive prior art distinguishing recitation in the claim other than the preamble, wherein it stated at 152 USPQ at page 239:

<sup>1</sup> "A taping machine."

<sup>2</sup> Citing Ellis for the point that "preambles are used primarily to give the field within which the invention has utility . . . rather than structure, form or composition."

"The references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of Kienzle."

In our claim, beyond the preamble there are express, not merely implied haec verba, references of:

"... a descending movement of said housing along said path of said pivotal traversing movement effective to establish the contacting by said cutting blade centrally of a start of a proposed cut therein during an initial pivotal traversing descent and during continued pivotal traversing descent a progressively enlargement thereof in opposite outward directions until said tile is shaped into two parts ...."

and such references must be considered on the issue of patentability.

Neither In re Casey nor In re Otto, cited therein, supports the Examiner's reliance on the dicta that "method steps . . . cannot . . . confer patentability on an apparatus claim" (at 152 USPQ page 238, left column) and that the Examiner can dismiss out of hand applicant's claim phrased substantively different than the claim of In re Casey.

Respectfully,

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Dated: May 8, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on May 8, 2002  
Dated: 5/8/02

Langella C. Glaser